UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,561	11/24/2003	Wai Hui	2030.78	5726

27683 7590 08/25/2004

HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

EXAMINER	
FRANCIS, FAYE	
ART UNIT	**PAPER NUMBER**
3712	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/720,561	HUI, WAI	
	Examiner	Art Unit	
	Faye Francis	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-8 and 10-11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Rehkemper et al, hereinafter Rehkemper in view of Gray et al, hereinafter Gray and Edmisson et al, hereinafter Edmisson.

Rehkemper discloses in Figs 1-7B, a radio-controlled toy car and controller kit, the kit comprising: an unassembled toy car [see the abstract] comprising a chassis [Fig 1] having a first pair of wheels [rear wheels], a motor [FA-130 motor] adapted to be removably inserted into the chassis [the motor is inherently capable of being removed from the chassis] and a controller [col 2 [0015]] for transmitting radio signals to the toy car as recited in claim 1. Additionally, Rehkemper discloses an axle, a second pair of wheels [the front wheels] as recited in claim 2, an axle gear, a drive gear and transfer gear [Fig 1] as recited in claims 5-6 respectively. Also, Rehkemper discloses a circuit board cover, which corresponds to the claimed motor retaining clip as recited in claim 8

Rehkemper may not disclose a pair of hubcaps adapted to be removably secured to the wheels, and a pair of tires adapted to be removably secured to the rear wheels.

Edmisson is cited to show desirability, in the relevant art, to provide a toy vehicle's wheels with tires [col 2 line 9]. It would have been obvious to one of ordinary

skill in the art at the time the invention was made to provide the wheels in the device of Rehkemper with the tires as taught by Edmisson in order to make the device more realistic.

Gray teaches the concept of providing to provide a toy vehicle's wheels with hubcaps 24 [col 2 line 34]. It would have been obvious to further provided the wheels in the modified device of Rehkemper with the hubcaps as taught by Gray in order to make the device more realistic.

3. Claim 9 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Rehkemper in view of Gray and Edmisson as applied to claims 1-8 and 10-11 above and further in view of Lam.

Modified device of Rehkemper has all the elements of this claim but for a wrist strap.

Lam teaches that it is conventional to attach a controller 200 to a wrist via a strap [mounting tapes 209 and 210]. It would have been obvious in view of Lam to further provide the device of Rehkemper with wrist strap to attach the controller to the hand of a user making the device more enjoyable for the children to play with.

Response to Arguments

4. Applicant's arguments filed 7/12/04 have been fully considered but they are not persuasive.

In response to applicant's argument on page 6 that even when combined, the references do not teach the claimed subject mater. The examiner would like to point out that the combination of Rehkemper, Gray, and Edmisson clearly teaches "a pair of

hubcaps adapted to be removably secured to the wheels". Since Gray teaches threaded front hubcaps 24 which screw on the extremities of the threaded spindles 22, the front hubcaps are being adapted to be removably secured to the front wheels 21 [one can unscrew the extremities of the threaded spindles in order to remove the front hubcaps.

Furthermore, the use of "adapted to" in line 3 of claim 1 makes what follows a functional statement and not a positive limitation because it has been held that the recitation that an element is "adapted to" to perform a function only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper **hindsight** reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, one of the ordinary skill in the art taking into account only knowledge which was within the level of his/her ordinary skill at the time the claimed invention was made, and without including knowledge gleaned only from the applicant's disclosure would have been motivated to further modify the device of Rehkemper as stated above.

In response to applicant's argument that the combination of references is improper, the examiner would like to point out that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969).

In this case, the artisan would have been motivated to further provided the wheels in the modified device of Rehkemper with the hubcaps as taught by Gray in order to make the device more realistic.

In response to applicant's argument that Gray teaches away from applicant's invention, the examiner would like to point out that Gray reference has been applied only to show that providing a toy vehicle's wheels with hubcaps is conventional.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700